REMARKS/ARGUMENTS

Claims 9 through 11, 14 through 22 and 24 remain in this application.

35 U.S.C. §112, FIRST PARAGRAPH, REJECTION

Claims 9 and 24 are rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure but not included in the claim(s). The above Office Action states Applicants have not claimed features of certain embodiments of the present invention that are critical or essential to the practice of the invention. In support of this rejection, the Examiner has cited *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Applicants respectfully traverse the Examiners rejection of claims 9 and 24 under 35 U.S.C. §112, first paragraph. In particular, Applicants respectfully assert that 35 U.S.C. §112 requires disclosure of critical or essential elements of an invention in the specification of a patent application, but 35 U.S.C. §112 does not require such critical or essential elements to be in the claims *per se*. All critical or essential elements of the present invention are fully described in the Detailed Description of the above application (pages 4 through 13) in accordance with 35 U.S.C. §112. In fact, *In re Mayhew* is specifically directed to the issue of whether a specification, not just the claims, provides an enabling description in accordance with 35 U.S.C. §112. In summary, the Examiner appears to have misinterpreted the requirements of 35 U.S.C. §112, first paragraph. Therefore, reconsideration and withdrawal of the 35 U.S.C. §112, first paragraph, rejection of claims 9 and 24 are respectfully requested.

35 U.S.C. §112, SECOND PARAGRAPH, REJECTION

Claims 9, 22 and 24 are rejected under 35 U.S.C. §112, second paragraph. The above Office Action states that it is not clearly claimed whether the electronic lock box holds keys, can store and process information, and is a communication bridge or router. Again, Applicants respectfully assert that the Examiner has misinterpreted 35 U.S.C. §112. 35 U.S.C. §112, second paragraph, requires claims that particularly point out and distinctly claim the subject matter of the invention. The scope of claims 9, 22 and 24 is quite clear; Applicants did not intend for any of these claims to be restricted to an electronic lock box that does or does not hold keys, can or cannot store and process information, and is or is not a communication bridge or router. In view of this wide breadth of the claims, it is up to the Examiner to determine whether any of these claims may be rejected under 35 U.S.C. §§102 and 103 (which the Examiner has done as evidenced by the Examiner's remarks at pages 6 through 14 of the above Office Action). 35 U.S.C. §112, second paragraph, is misplaced and does not apply to this particular issue presented by the Examiner, and 35 U.S.C. §103 is the appropriate rule to apply for this issue. In view of the above, reconsideration and withdrawal of the 35 U.S.C. §112, second paragraph, rejection of claims 9, 22 and 24 are respectfully requested.

It should be noted that the above Office Action does not properly cite a reference identified at "SupraKey". Apparently, based on text at page 5 of the above Office Action, SupraKey is a security product of the General Electric Company. The Examiner has not properly cited this reference on USPTO Form PTO-892, which requires a publication date for determination of whether it may be considered prior art relative to the present invention.

35 U.S.C. §103(A) REJECTION

Claims 9 through 11, 14 through 22 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentably over U.S. Patent No. 4,766,746 to Henderson, et al. ("Henderson, et al. patent") in view of U.S. Patent No. 5,791,172 to Deighton, et al. ("Deighton, et al. patent") and U.S. Patent No. 5,793,882 to Piatek, et al. ("Piatek, et al. patent").

Claim 9 provides, *inter alia*, an electronic lock box that wirelessly communicates information about the real estate property, including at least one of the group comprising a price of the real estate property, a square footage of the real estate property, a virtual tour of the real estate property, a number of bedrooms within the real estate property and an availability of the real estate property, and claims 22 and 24 as amended provide, *inter alia*, similar language.

The above Office Action admits that the Henderson, et al. patent, the Deighton, et al. patent, and the Piatek, et al. patent do not teach information about the real estate property including at least one of the group comprising a price of the real estate property, a square footage of the real estate property, a virtual tour of the real estate property, a number of bedrooms within the real estate property and an availability of the real estate property. The above Office Action further states official notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to elect what information needs to be transmitted to the receive to meet business requirements. In the previous response of

April 1, 2005, Applicants traversed the Examiner's assertion of official notice and requested documentary evidence pursuant to 37 C.F.R. §1.104(c)(2) if the rejection is to be maintained.

The above Office Action fails to provide the documentary evidence requested by the Applicants in the previous response. See §2144.03 of the MPEP. Therefore, the issuance of a final rejection is improper and Applicants request re-issuance of this Office Action as a non-final rejection.

Also, since the above Office Action fails to provide the requested documentary evidence, it is clear that claims 9, 22 and 24 distinguish patentably from the Henderson, et al. patent, the Deighton, et al. patent, the Piatek, et al. patent, and any combination of these patents.

Claims 10, 11 and 14 through 21 depend from and include all limitations of independent claim 9 as amended. Therefore, claims 10, 11 and 14 through 21 distinguish patentably from the Henderson, et al. patent, the Deighton, et al. patent, the Piatek, et al. patent, and any combination of these patents for the reasons stated above for independent claim 9.

In view of the above, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 9 through 11, 14 through 22 and 24 are respectfully requested.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope

of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,
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